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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,306	04/13/2004	Edith Cohen	113062 CON-1	4748
7590 Samuel H. Dworetsky AT&T P.O. Box 4110 Middletown, NJ 07748		02/22/2007	EXAMINER PARDO, THUY N	
			ART UNIT 2165	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/22/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/823,306	Applicant(s) COHEN ET AL.	
	Examiner Thuy N. Pardo	Art Unit 2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-40 and 43-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-40 and 43-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>4/13/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's Preliminary Amendment filed on April 13, 2007 has been reviewed. Claims 14-40 and 43-46 are pending in the application. Claims 1-13 and 41-42 have been canceled, and claims 14-17, 20-23, 25, 29, 34, 37-40, 43 and 46 have been amended.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 20-33, 34-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For instance, the limitations of "analyzing a volume of resources related to said first resource using said received proxy filter so as to identify at least a second resource of potential interest to said proxy server" found in claim 20, "comparing the retrieved last modification time and said information regarding a last modification time included in said request; and retrieving another copy of said first resource when said step of comparing indicates that said modification time for said first resource at said resource server differs from said last modification time for said first resource included in said request" found in claim 25, and

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“analyzing the directory prefix of each of a said plurality of resources; dividing the resources into a plurality of subsets based on matching directory prefixes of the resources to a predetermined prefix level” found in claim 37 have not been described in the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 43-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding to claim 43, the limitation of “if said step of analyzing indicates that at least one resource has been modified” renders the claims indefinite and incomplete because the claims include elements not actually happened (those encompassed by " if a resource is modified"), and what is happened if a resource is not modified, thereby rendering the scope of the claims unascertainable. See MPEP § 2173.05(d).

Regarding to claim 46, the limitation of “analyzing said information to determine if said information...is not stored at said cache” renders the claims indefinite and incomplete because the claims include elements not actually happened (those encompassed by " if said information...is not stored at said cache”), and what is happened if said information is stored at that cache, thereby rendering the scope of the claims unascertainable. See MPEP § 2173.05(d).; and in response to the step of analyzing, fetching a resource not stored in said cache

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 14-40 and 43-46 are rejected on the ground of nonstatutory double patenting over claims 1-4 of U. S. Patent No. 6,330,561 and claims 1-12 of U.S. Patent No. 6,751,608 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a method for transferring information to a proxy server.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 14 and 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Logue et al. (Hereinafter "Logue") US Patent No. 5,935,207.

Referring to claim 14, Logue teaches a method for effecting a transfer of information to a proxy server, said proxy server having a cache storing a plurality of resources, the method performed at a resource server, the method comprising the steps of:

receiving a request from a proxy server, wherein the request seeks information about a particular resource [request from remote site, 810 of fig. 8];

retrieving information regarding said particular resource in response to said request [dispatching document requests in a proxy to more efficiently allocate the document cache space within the proxy, col. 2, lines 21-32];

examining a volume of resource information with which said particular resource is associated, said volume also including information relating to resources other than said particular resource [determines if the URL of the document retrieved from the proxy's local cache is one of the hits is to be tracked..., col. 8, lines 56 to col. 9, lines 4];

compiling information from a subset of said volume of resource information [tracking list record, col. 7, lines 36 to col. 8, lines 28; fig. 5A-5B]; and

generating a response to the received request using the retrieved information and the compiled information [accumulated site hit records are provided to the corresponding remote site administrator, col. 7, lines 59-67].

Referring to claim 16, Logue teaches the invention substantially as claimed. Logue further teaches that the retrieved information includes a copy of the particular resource [copies of URLs in a tracking list record, fig. 5A-5B].

Referring to claim 17, Logue teaches the invention substantially as claimed. Logue further teaches that the retrieved information includes an indication of when the requested particular resource was last modified [URLs counts since the last report and a timestamp that identifies the starting point of the accumulation in the report, col. 9, lines 44-54; 525 of fig. 5B].

Referring to claim 18, Logue teaches the invention substantially as claimed. Logue further teaches that the compiled information includes an identifier for said at least one further resource [“companyA”, fig. 6].

Referring to claim 19, Logue teaches the invention substantially as claimed. Logue further teaches that said compiled information includes attribute information regarding said at least one further resource [fig. 5A-5B and fig. 6; col. 6, lines 60 to col. 8, lines 42].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 15, 20-28, 30-33, 37-40 and 43-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logue et al. (Hereinafter “Logue”) US Patent No. 5,935,207 in view of Savitzky et al. (hereinafter “Savitzky”) US Patent No. 6,012,083.

Referring to claim 15, Logue teaches the invention substantially as claimed, with the exception of receiving a proxy filter with said request from said proxy server and compiling information based, at least in part, on said proxy filter although it has the same functionality of tracking total hits to a received request from a proxy server. Savitzky teaches receiving a proxy

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filter and compiling information based on the proxy filter [filter agent 52 in the proxy agency 32, fig. 4; col. 11, lines 22 to col. 12, lines 10]. It would have been obvious to one of ordinary skill in the art at the time of the invention to add this feature of Savitzky to the system of Logue as essential means to increase the efficiency and accuracy of tracking accumulated site hits to the requester.

Referring to claim 20, Logue and Savitzky teach the invention substantially as claimed. Logue further teaches analyzing a volume of resources related to said first resource [analyzing in a certain areas of their web site, col. 8, lines 14-16] and to track the relative popularity of a page, col. 1, lines 56-59], and generating a response to said request based on the retrieved information and the identified attribute information accumulated site hit records are provided to the corresponding remote site administrator, col. 7, lines 59-67; fig. 5A-5B]. Savitzky teaches using said received proxy filter so as to identify at least a second resource of potential interest to said proxy server; identifying attribute information regarding said at least a second resource [gathers additional documents according to filtering rules, col. 11, lines 27-42; col.1, lines 30-45].

Referring to claim 21, Logue and Savitzky teach the invention substantially as claimed. Savitzky further teaches that said proxy filter includes a selection parameter for choosing one or more resources from a volume of resources related to said first resource [col. 11, lines 27-42; col.1, lines 30-45].

Referring to claim 22, Logue teaches the invention substantially as claimed. Logue further teaches that said selection parameter is selected from a group of resource attributes that includes, resource size, resource content type, a resource change rate and a resource request frequency [col. 5, lines 38-42].

Referring to claims 23-28 and 30-33, 37-40 and 43-46, all the limitations of these claims have been addressed in the analysis above, and these claims are rejected on that basis.

Allowable Subject Matter

7. Claims 29, 34-36 and 47 are allowed.

The following is an examiner's statement of reasons for allowance:

the prior art of record fails to teach or suggest individually or in combination detecting when a first resource is requested of the resource server; identifying a second resource that is requested from said resource server within a time period following the request for the first resource; determining a probability that said resource will also be requested if said first resource is requested; and if said probability satisfies a minimum threshold then associating said first resource and said second resource in a volume as set forth in the independent claim 29, and creating a volume of resources from a plurality of resources available to a server, each of said plurality of resources having an associated directory prefix, analyzing the directory prefix of each of a said plurality of resources; dividing the resources into a plurality of subsets based on matching directory prefixes of the resources to a predetermined prefix level and associating resources in at least one of said plurality of subsets in a respective volume, wherein each said

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volume includes an identifier for each resource associated with the respective volume as set forth in the independent claim 34,

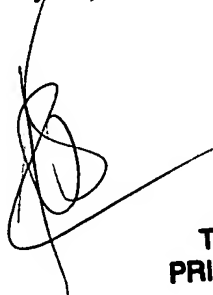
Claims 35, 36 and 47 further limiting to claims 29 and 34 are also allowed.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy N. Pardo whose telephone number is 571-272-4082. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

February 17, 2007



**THUY N. PARDO
PRIMARY EXAMINER**